

## **REMARKS**

### **Formal Matters**

In the specification, the paragraph at page 89, lines 23-32 has been amended to correct minor editorial problems.

Claims 20, 22, 26-28 & 31-36 remain in this application. Claims 1-19, 21, 23-25, 29-30 have been canceled. Claims 20, 22, 26, 28 are amended and new claims 31-36 are added. No new matter is added by the amendments.

Support for the amendments is found throughout the specification, and at least as specifically indicated below.

Claim 20: Figure 2, page 3, lines 17-20 and Figure 2.

Claim 26: page 2, lines 34-35.

Claim 31: page 29, lines 3-13.

Claim 32: page 30, lines 27-31.

Claim 33: *binding to IL-18R* - page 26, lines 6-10; *differential binding* - Example 9; *substitutions, additions, deletions* - page 20, lines 6-21.

In view of the Examiner's earlier restriction requirement, applicant retains the right to present cancelled claims 1-19, 21, 23-25, 29-30 in a divisional application.

### **Objections and Informalities:**

The Examiner has objected to an informality in the specification, which has been corrected in the present amendment.

The Examiner has further objected to Claims 20 and 25 as being dependent upon a non-elected claim, and to Claim 22 for encompassing non-elected subject matter.

In response, Applicants' amendments have rendered the Examiner's concerns moot.

The Rejection Under 35 U.S.C. § 112, Second Paragraph:

Claims 20 and 25-28 are rejected under 35 U.S.C. § 112, second paragraph because, allegedly, these claims allegedly fail to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner has made specific allegations against Claims 20, 25 and 26, while Claims 27 and 28 are rejected for depending from an allegedly indefinite claim.

Claim 20 is alleged to be problematic for allegedly containing the language “the IL-11p”, which lacks antecedent basis.

In response, Applicants cannot find the offending language in the wording of Claim 20. However, Applicants respectfully submit that the present amendments to Claim 20 submitted herewith render any such rejections moot.

Claim 25 is alleged to be indefinite because it is unclear which DNA encodes SEQ ID NO:5, while Claim 26 is indefinite because of the terminology “naturally occurring”.

In response, the cancellation of Claim 25 and the amendment of Claim 26 renders the rejection moot.

Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 20 and 25-28 under 35 U.S.C. § 112, second paragraph.

The Rejection Under 35 U.S.C. § 112, First Paragraph:

Claim 26 and the dependent claims 27 and 28 are rejected under 35 U.S.C. § 112 first paragraph, allegedly because the specification, while enabling for claims limited in scope to a polypeptide of SEQ ID NO:5, does not reasonably provide enablement (allegedly) for claims to any “*naturally occurring allelic variant*” thereof (encompassed by “a native amino acid sequence of the IL-11p” in Claim 26). The Examiner alleges that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claim 26 and the dependent claims 27 and 28 are further rejected under 35 U.S.C. § 112 first paragraph, for containing subject matter which allegedly was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In response, the cancellation of the offending language from Claim 26 renders the rejection moot. Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 26-28 under 35 U.S.C. § 112 first paragraph.

The First Rejection Under 35 U.S.C. § 102(e):

Claims 20, 22 and 25-28 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Timans, U.S.P. 6,680,380.

Specifically, the Examiner alleges that U.S.P. 6,680,380 discloses residues 35-203 of Applicants SEQ ID NO:5, and as a result, anticipates a polypeptide comprising residues 37-203 of SEQ ID NO:5.

In response, Applicants respectfully submit the amendments render the rejection moot. Moreover, U.S.P. 6,680,380 does not teach any specific or credible utility for SEQ ID NO:5, much less a specific and differential binding to IL-18R ECD but not IL-1R ECD. Thus, Applicants have at the very minimum, isolated an operative and non-obvious fragment of the polypeptides disclosed in Timans.

The Second Rejection Under 35 U.S.C. § 102(e):

Claims 20, 22 and 25-28 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Sims et al., US2003/0091532 A1.

Specifically, the Examiner alleges that Sims *et al.*, discloses residues 33-203 of Applicants SEQ ID NO:5, and as a result, anticipates a polypeptide comprising residues 37-203 of SEQ ID NO:5.

In response, Applicants respectfully submit the amendments render the rejection moot. Moreover, Sims et al. does not teach any specific or credible utility for SEQ ID NO:5, much less a specific and differential binding to IL-18R ECD but not IL-1R ECD. Thus, Applicants have at the very minimum, isolated an operative and non-obvious fragment of the polypeptides disclosed in Sims *et al.*

Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 20, 22 and 25-28 are rejected under 35 U.S.C. § 102(e).

**SUMMARY**

Claims 20, 22, 26-28 and new claims 31-36 are pending in the application. Claims 1-19, 21, 23-25 and 29-30 are canceled without prejudice to later prosecution.

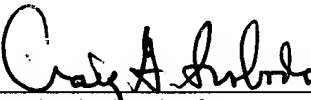
If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the subject application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

This response/amendment is submitted with a transmittal letter and petition for a Three-month extension of time and fees. In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
GENENTECH, INC.

Date: March 14, 2005

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